

### REMARKS

Claims 1-4, 7-17 and 20-30 are now pending in the present application. Claims 1, 3, 4, 7-11, 14, 16, 17, 20-24, 27 and 29 have been amended, and Claims 5, 6, 18 and 19 have been cancelled, herewith. Reconsideration of the pending claims is respectfully requested.

#### **I. 35 U.S.C. § 103, Obviousness**

The Examiner rejected Claims 1-30 under 35 U.S.C. § 103 as being unpatentable over US Patent Publication US 2004/0073676 to Honma et al in view of US Patent 4,864,438 to Munro. This rejection is respectfully traversed.

Claim 1 has been amended to include features of Claim 6 (which is thus being cancelled herewith without prejudice or disclaimer). The following discussion is therefore in response to the Examiner's rejection of Claim 6 in the present Office Action, as those features are now a part of amended Claim 1.

As to amended Claim 1, Appellants urge that it is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claims as a "blueprint". When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. "...absence of such suggestion to combine is dispositive in an obviousness determination". *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). Appellants urge that there is simply no teaching, suggestion or other reason to modify the teachings of Munro to include a classified data storage system, as previously recited in Claims 6 and 19 (and now recited in amended Claims 1 and 14). The only motivation for inclusion of a classified automated data storage system comes from Appellants' own patent disclosure, which is improper hindsight analysis. Munroe makes no mention of any desire for implementing a classified data storage system, and thus provides no motivation to modify the teachings contained therein to include such a classified automated data storage system.

Further, while the cited Honma reference alludes to providing data storage restrictions using a front-end fiber channel switch, such teaching does not teach or suggest both an

unclassified and a classified automated data storage system that complies with a government security classification, as expressly recited in Claim 6. Thus, even when the references have been combined using improper hindsight analysis, there is still a missing claimed feature – strongly evidencing non-obviousness.

Further, the fact that the Honma reference describes restricted paths to access data storage (such restriction being accomplished by a separate fiber channel switch) does not provide any motivation *to modify the teachings of the cited Munroe reference* in accordance with the claimed invention. Restated, a mere teaching of security concerns in one reference does not provide motivation to modify another reference which has no security classification concerns. To find otherwise would effectively eliminate the teaching/suggestion/motivation requirement that is expressly required by well-established case law, as any reference that describes 'anything' could be used as motivation to modify another reference to include the 'anything' even though the another reference is not concerned with the 'anything'. This certainly is not the law regarding a requirement for a motivation to modify a reference, as such an interpretation would effectively eliminate the motivation requirement as motivation would always exist no matter what.

Still further, due to the Munro architecture, there is no ability to provide such a secured environment, *as the LSM's share a common network* (Figure 1, elements 162 and 163) with no ability to only allow data flow to a high security level but not allow data flow to a lower security level (Specification page 6, lines 11-16). The Munro architecture is expressly required to allow unfettered data sharing between the LSMs (see Munro column 3, lines 14-27, where it states "Thus, by coordinating the operation of a plurality of automated tape cartridge library modules, each and every tape cartridge in the library can be mounted on any selected tape drive unit in the entire complex"), and to reserve particular paths for efficient transport between such LSMs (Munro column 6, 12-38), both of which are expressed purposes/advantages of the Munro teachings. To somehow re-architect the teachings of Munro to provide a classified environment would eviscerate the Munro's path reservation system and unfettered access to media within the entire complex, further evidencing no motivation to modify the teachings of Munro in accordance with the claimed invention.

Thus, it is shown that the references have been improperly combined using improper hindsight analysis, and even when improperly combined there are still missing claimed features. To establish prima facie obviousness of a claimed invention, all of the claim limitations must be

taught or suggested by the prior art. MPEP 2143.03 (emphasis added by Appellants). *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). Thus, Claims 6 and 19 are shown to have been erroneously rejected under 35 USC 103 as all the claimed limitations are not taught or suggested by the cited references, and by the Examiner's use of improper hindsight analysis. As Claims 1 and 14 have been amended to now include the features from Claims 6 and 19, respectively, it is urged that amended Claims 1 and 14 are not obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 2-4 and 7-13 for reasons given above with respect to Claim 1 (of which Claims 2-4 and 7-13 depend upon).

Further with respect to Claim 3, such claim has been amended in accordance with the preferred embodiment shown by Applicants' Figure 6. It is urged that none of the cited references teach or suggest this claimed configuration, where the only common connection between the two storage libraries is by way of a pass-through port – which significantly improves overall data security processing by maintaining adherence to government security requirements, while at the same time providing data cartridge automation capabilities in such an environment (Specification page 4, line 21 – page 5, line 17). Thus, it is further urged that amended Claim 3 is not obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 14-17 and 20-29 for similar reasons given above with respect to Claim 1.

Applicants further traverse the rejection of Claim 16 for similar reasons to the further reasons given above with respect to Claim 3.

With respect to Claim 30, such claim recites "wherein the transportation device protects against transporting the data storage unit from the second data storage device back to the first data storage device". None of the cited references teach or suggest this claimed feature, nor has the Examiner alleged any such teaching or suggestion. Thus, a prima facie case of obviousness has not been established with respect to Claim 30<sup>1</sup>, and therefore the burden has not shifted to Applicants to rebut this obviousness assertion<sup>2</sup>. In addition, as a prima facie showing of

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<sup>1</sup> To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

<sup>2</sup> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

obviousness has not been properly established, Claim 30 has been erroneously rejected<sup>3</sup>.

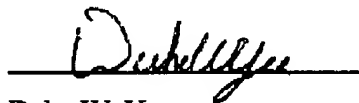
Therefore, the rejection of Claims 1-30 under 35 U.S.C. § 103 has been overcome.

## II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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<sup>3</sup> If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).